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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91160266
Party	Plaintiff Christopher Brooks Christopher Brooks 83 Myrtle Boulevard Larchmont, NY 10538 UNITED STATES
Correspondence Address	EVAN GOURVITZ FROSS ZELNICK LEHRMAN & ZISSU, P.C. 866 UNITED NATIONS PLAZA NEW YORK, NY 10017 UNITED STATES egourvitz@frosszelnick.com
Submission	Other Motions/Papers
Filer's Name	Evan Gourvitz
Filer's e-mail	egourvitz@frosszelnick.com
Signature	/Evan Gourvitz/
Date	02/23/2007
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 75/761,159

Mark: CAB CALLOWAY

Opposer's Ref: CWBK 04/18950

	X	
CHRISTOPHER BROOKS,	:	
	:	
Opposer,	:	
	:	
- v. -	:	Opposition No. 91/160,266
	:	
CREATIVE ARTS BY CALLOWAY, LLC,	:	
	:	
Applicant.	:	
	:	
	X	

**REPLY BRIEF IN FURTHER SUPPORT OF MOTION FOR RECONSIDERATION
OF THE BOARD'S DECEMBER 21, 2006 ORDER DENYING SUMMARY JUDGMENT**

Opposer, Christopher Brooks (“Opposer”), pursuant to 37 C.F.R. § 2.127(b) and TBMP § 518, submits this reply brief in further support of his motion for reconsideration of the Board’s December 21, 2006 order denying Opposer’s motion for summary judgment.

PRELIMINARY STATEMENT

It is ironic that Applicant Creative Arts by Calloway, LLC (“Applicant”) inaccurately challenges Opposer’s motion for reconsideration as seeking to reargue the same “basic issue” when, as demonstrated below, Applicant’s only basis for opposing reconsideration – and summary judgment in Opposer’s favor – is to reargue issues that Applicant already has conceded, and that principles of *res judicata* prohibit Applicant from relitigating before the Board.

As noted in Opposer’s original brief (Opp. 1/19/07 Mem. at 2), the sole issue raised in this motion for reconsideration is whether the Board erred in determining that

this proceeding is not amenable to summary disposition because genuine issues of material fact remain with respect to the issue of priority. *Applicant has alleged and has submitted evidence purporting to show prior use of the involved mark through The Cab Calloway School of the Arts, asserted by applicant to be its licensee, in connection with musical, concert and theatrical productions.* This is sufficient to raise a genuine issue of material fact concerning priority.

(12/21/06 Opinion at 3) (emphasis added).

Tellingly, in its brief in response to this motion Applicant seeks to avoid this issue. The reason for this is simple: Applicant already has admitted that the Cab Calloway School of the Arts (the “School”) was *not* its licensee, and the School’s merely honorific use of “Cab Calloway” does not grant Applicant any right to use CAB CALLOWAY as a service mark for musical, concert and theatrical productions.

More specifically, in a 2001 deposition in an earlier action between the same parties, Applicant **admitted** that *no* entity except a t-shirt company had *any* “license or permission”

from Applicant or its predecessors to use the CAB CALLOWAY mark on any goods or services. (Opp. 7/21/05 Gourvitz Reply Decl. (“Gourvitz Decl.”), Ex. 20 (Langsam Depo.) at 38:17-22.) This admission, among others, led the U.S. District Court for the Southern District of New York and the U.S. Court of Appeals for the Second Circuit to hold and affirm that, *inter alia*, Applicant had no service mark rights in CAB CALLOWAY in connection with entertainment services. Applicant **conceded** this holding and affirmation in its response to Opposer’s summary judgment motion. (App. 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶¶ 21-22.)

Given the absence of any disputed issue of material fact as to Applicant’s ability to claim any prior rights in the CAB CALLOWAY mark, Applicant seeks to confuse the issue, and create a nonexistent dispute, by raising the issue of Opposer’s own priority. (App. 2/7/07 Mem. at 2-4.) This matter was not raised by the Board as an issue of material fact in its decision (*see* 12/21/06 Opinion at 3), has been definitively addressed by uncontroverted evidence in Opposer’s motion papers, and already has been **conceded** in Applicant’s own motion papers. (App. 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶¶ 9-11.) This tactic must fail.

There simply is no remaining dispute of any material fact, or even any dispute, as to the single issue raised by the Board in its opinion – whether Applicant may have priority in its use of CAB CALLOWAY as a service mark for musical, concert and theatrical productions through its purported licensee the School. Given Opposer’s evidence that the Board was mistaken on that single issue, the Board should reconsider that opinion and grant Opposer summary judgment.

ARGUMENT

Despite Applicant’s accusations that Opposer is seeking to “steal” summary judgment by “nit-pick[ing]” the Board’s December 21, 2006 decision (App. 2/7/07 Mem. at 2), “[t]he summary judgment procedure is regarded as ‘a salutary method of disposition,’ and the Board

does not hesitate to dispose of cases on summary judgment where appropriate.” TBMP § 528.01 (citations omitted). Indeed, summary judgment is an ideal method of disposing of this action, where only one issue was raised by the Board and, as demonstrated in Opposer’s moving brief and below, there is no conflicting evidence on this issue.

I. THERE IS NO EVIDENCE IN THE RECORD THAT APPLICANT OR ITS PREDECESSORS LICENSED USE OF THE CAB CALLOWAY MARK TO THE SCHOOL FOR ENTERTAINMENT SERVICES

Here, the rule of collateral estoppel precludes the Board from finding that Applicant succeeded to any trademark or service mark rights that Mr. Calloway is claimed to have licensed to the School. *Mother’s Restaurant Inc. v. Mama’s Pizza, Inc.*, 221 U.S.P.Q. 394, 397-99 (Fed. Cir. 1983) (issues actually and necessarily determined by court of competent jurisdiction legally conclusive in a subsequent suit between those parties). In the prior litigation between the parties, the U.S. District Court for the Southern District of New York found that there was “no evidence that [Cab Calloway] had or exercised any common law service mark in his name,” *Creative Arts by Calloway, LLC v. Brooks*, No. 01 Civ. 3192 (CLB) (S.D.N.Y. Dec. 11, 2001) mem. op. at 7 (previously submitted as Gourvitz Decl., Ex. 14), and the U.S. Court of Appeals for the Second Circuit affirmed, finding that Cab Calloway had no rights in his name as a mark to transfer to his successors. *Creative Arts by Calloway, LLC v. Brooks*, No. No. 02-7050, 2002 WL 31303241, at *2 (2d Cir. Oct. 11, 2002) (previously submitted as Gourvitz Decl., Ex. 15). In the words of the Court, “Cab Calloway was not operating a going concern at the time of his death, precluding the transfer of a mark.” *Id.* Applicant cannot and does not contest these findings by the courts.

Applicant also cannot and does not deny its own sworn statement in a 2001 deposition in that earlier action between the parties that, as of that date, Applicant had *not* granted *any* “license or permission” to use the CAB CALLOWAY mark to *any* third party, other than one t-shirt

company, for *any* goods or services. (Gourvitz Decl., Ex. 20 (Langsam Depo.) at 38.) This prior admission by Applicant, which it has not denied or even sought to explain, constitutes dispositive proof that as of 2001 Applicant had not acquired any rights in the CAB CALLOWAY mark by licensing that mark to the School for entertainment services (or, for that matter, any other goods or services). *See* TBMP § 528.01 (to defeat summary judgment “nonmoving party . . . must proffer *countering evidence, by affidavit or as otherwise provided* in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial”) (emphasis added); Fed. R. Civ. P. 56(e); *see also* Fed. R. Evid. 801(d)(2) (admission by party-opponent).

Faced with these undisputed facts, Applicant nevertheless insists that summary judgment is precluded because, in a 2005 declaration, Applicant’s representative stated that (1) the School sought “permission” and Cab Calloway “authorized” it to “use his name as the name of the school,” (2) the School has used CAB CALLOWAY as a service mark in connection with its own plays and musical performances, and (3) Cab Calloway and his successors “authorized” the School to sell “various clothing items, school supplies, and other *products* bearing the CAB CALLOWAY mark . . . pursuant to its license from Cab Calloway and his Estate to do so.” (App. 2/7/07 Mem. at 4-5) (emphasis added).

First, leaving aside the fact that the last of these statements contradicts Applicant’s own prior sworn deposition testimony (noted above), none of these statements on its face says that Applicant or its predecessors **licensed** the use of the CAB CALLOWAY mark to the School for **“musical, concert and theatrical productions,” or any other entertainment services.** The Supreme Court has decreed that “the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material fact*,” *Anderson v. Liberty Lobby, Inc.*,

477 U.S. 242 (1986), a rule that is dispositive here, where none of the above statements from Applicant's declaration even addresses the sole matter at issue. Second, it is basic that without a license the School's use *on its own* of CAB CALLOWAY as a service mark (item 2, above) cannot, as a matter of law, inure to Applicant's benefit for purposes of establishing priority. *See, e.g., In re Raven Marine, Inc.*, 217 U.S.P.Q. 68, 69 (T.T.A.B. 1983) (rejecting claim of use of mark through third party without sufficient evidence of license).

II. THERE ALSO IS NO MATERIAL DISPUTE OF FACT CONCERNING OPPOSER'S PRIOR RIGHTS

Because Applicant has not introduced and cannot introduce evidence of its own prior service mark use of the mark CAB CALLOWAY (which, given the later date in its intent-to-use application, it would have to prove by "clear and convincing" evidence, *e.g., Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 1 U.S.P.Q. 1772, 1773 (Fed. Cir 1987)), it seeks to raise a material dispute of fact about Opposer's own use of THE CAB CALLOWAY ORCHESTRA, even though the Board did not raise this issue as a basis for its denial of summary judgment in its December 21, 2006 opinion. (*See generally* 12/21/06 Opinion at 3)

Applicant correctly acknowledges that its priority date is no earlier than the filing date of its intent-to-use application, July 23, 1999. (App. Mem. at 2.) It therefore claims that for Opposer to show priority he must show that, prior to that date, CAB CALLOWAY had "come in the public mind to identify [Opposer's] services." (*Id.* at 3.) This is demonstrably incorrect.

First, Applicant deliberately misstates the record and Opposer's mark, which is not CAB CALLOWAY but THE CAB CALLOWAY ORCHESTRA. (*E.g.*, Brooks 12/28/04 Decl. at ¶¶ 7-15.) Considered as a whole, this composite mark is distinctive. *E.g., In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554 (Fed. Cir. 1988); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 346 (2d Cir. 1999); *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S.

538, 545-46 (1920). Even by itself, CAB CALLOWAY alone is a distinctive “historical” name that does not require secondary meaning to be protected. *E.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 13:25 (4th ed. 2005); Restatement (Third) of Unfair Competition § 14, comment *e* (1995); *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 165 U.S.P.Q. 459, 461 (S.D.N.Y. 1970). Indeed, Applicant has conceded that no proof of secondary meaning is necessary by seeking to register CAB CALLOWAY on an intent-to-use basis without submitting any proof of secondary meaning. *See* TMEP § 1212.06 (actual evidence of distinctiveness).

Second, Applicant already conceded that Opposer began using his own mark before Applicant filed its application to register CAB CALLOWAY. As Applicant acknowledged in its brief, many of the statements in Opposer’s statement of undisputed material facts are “conceded [by Applicant] to be undisputed.” (App. 2/7/07 Mem. at 1.) Among other things, Applicant admitted in response to Opposer’s summary judgment motion that (1) “*Applicant does not dispute* that since sometime in 1999 Opposer has made sporadic sales of compact discs and videos that have born[e] that mark THE CAB CALLOWAY ORCHESTRA,” (2) “Opposer has . . . demonstrated the sale of . . . twenty compact discs *prior to Applicant’s July 23, 1999 filing date*,” and (3) “Opposer has . . . demonstrated the sale of . . . six video tapes *prior to Applicant’s July 23, 1999 filing date*.” (App. 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶¶ 9-11) (emphasis added). These statements show that there is no material dispute of fact about Opposer’s priority. *See* Fed. R. Civ. P. 56(e) (to avoid summary judgment nonmoving party may not rest upon “mere allegations or denials,” but must set forth specific facts showing genuine issue for trial).

Third, Applicant ignores (without disputing) the evidence of prior use that Opposer introduced into the record, including a sworn declaration and documentary evidence, showing his use of THE CAB CALLOWAY ORCHESTRA as a trademark and service mark for entertainment-related goods and services prior to Applicant's filing of its own application. (*E.g.*, Brooks 12/28/04 Decl. at ¶¶ 12-13; Exs. 8-11.)

Given the above, there can be no genuine issue of material fact that Opposer commenced his use of THE CAB CALLOWAY ORCHESTRA before Applicant applied to register its mark, and therefore has priority.

III. OPPOSER'S BRIEF IS NOT PROCEDURALLY IMPROPER

Finally, Applicant contends that Opposer's motion is improper because it addresses the same issue as Opposer's first motion to reconsider, namely "that there are factual issues in dispute." (App. 2/7/07 Mem. at 5.) This ignores the fact that the Board gave different reasons for each of its two decisions. The issue in Opposer's first request for reconsideration concerned the relatedness of the parties' goods and services (*see* 11/23/05 Opinion at 2), while the present request for reconsideration concerns the Board's holding that there is a genuine issue of material fact concerning Applicant's allegations of prior service mark use of CAB CALLOWAY through the School for musical, concert and theatrical productions (*see* 12/21/06 Opinion at 3).

Obviously, it is Applicant – who to Opposer's knowledge has yet to make any use of the CAB CALLOWAY mark – who is grasping at straws to keep its application alive and delay judgment against it, even if that means disregarding the legally preclusive effect of the prior litigation between the parties, misstating the record, ignoring conceded facts, and even trying to prevent Opposer from exercising its rights under the Federal Rules of Civil Procedure as made

applicable by the Trademark Rules of Practice. (*See* App. 2/7/07 Mem. at 6.) *Cf. Dickinson v. Zurko*, 527 U.S. 150, 152 (1999) (Federal Circuit will not uphold Board's factual findings if arbitrary, capricious, an abuse of discretion, or unsupported by substantial evidence).

Applicant's submission should be seen for what it is – a desperate attempt to prevent entry of summary judgment against it despite the preclusive effect of the parties' prior litigation, and the undeniable lack of any evidence of a dispute of material fact supporting any of Applicant's arguments or claims.

CONCLUSION

For the reasons set forth above and in its previous brief in support of this motion, the Board should (i) reconsider the previously-overlooked, undisputed evidence that Applicant did not license the CAB CALLOWAY mark to the School; (ii) reconsider the question of priority on this basis, and on the basis of the federal courts' prior determinations on this issue; and (iii) grant summary judgment to Opposer and deny registration to Applicant's intent-to-use Application Serial No. 75/761,159 to register CAB CALLOWAY under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Dated: New York, New York
February 23, 2007

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____

Barbara A. Solomon
Evan Gourvitz
866 United Nations Plaza
New York, New York 10017
Phone: (212) 813-5900
Fax: (212) 813-5901
Attorneys for Opposer

CERTIFICATE OF SERVICE

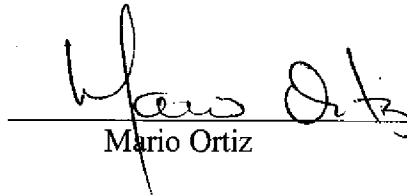
I hereby certify that true and correct copy of the REPLY BRIEF IN FURTHER
SUPPORT OF MOTION FOR RECONSIDERATION OF THE BOARD'S DECEMBER 21, 2006
ORDER DENYING SUMMARY JUDGMENT, was served via first class mail to the following:

Anthony L. Fletcher, Esq.
Citigroup Center
153 East 53rd St.
New York, NY 10022-4611

Cynthia Johnson Walden, Esq.
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

Joel D. Leviton, Esq.
60 South Sixth Street
3300 Dain Rauscher Plaza
Minneapolis, MN 55402

Attorneys for Applicant Creative Arts by Calloway, LLC, on this 23rd day of February 2007.


Mario Ortiz